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|  |     | Application Number     | 09/513,646       |
|  |     | Filing Date            | 02/25/2000       |
|  |     | First Named Inventor   | Daniel A. Ford   |
|  |     | Art Unit               | 2645             |
|  |     | Examiner Name          | Ovidio Escalante |
| Total Number of Pages in This Submission | 124 | Attorney Docket Number | AM9-99-0165      |

Total Number of Pages in This Submission

## ENCLOSURES (Check all that apply)

|  |   |  |
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| <input checked="" type="checkbox"/> Fee Transmittal Form                     | <input type="checkbox"/> Drawing(s)                                       | <input type="checkbox"/> After Allowance communication to Technology Center (TC)                   |
| <input type="checkbox"/> Fee Attached  | <input type="checkbox"/> Licensing-related Papers                         | <input checked="" type="checkbox"/> Appeal Communication to Board of Appeals and Interferences     |
| <input type="checkbox"/> Amendment/Reply                                     | <input type="checkbox"/> Petition   | <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) |
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| <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 |   |  |

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

|                         |   |
|-------------------------|---|
| Firm or Individual name | Leonard T. Guzman (Registration No. 46,308) |
| Signature               |   |
| Date                    | 10/16/2004                                  |

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Effective 10/01/2003. Patent fees are subject to annual revision.

 Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 340.00)

## Complete if Known

|                      |                   |
|----------------------|-------------------|
| Application Number   | 09/513,646        |
| Filing Date          | 02/25/2000        |
| First Named Inventor | Daniel A. Ford    |
| Examiner Name        | Escalante, Ovidio |
| Art Unit             | 2645              |
| Attorney Docket No.  | AM9-99-0165       |

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## FEE CALCULATION

## 1. BASIC FILING FEE

| Large Entity        | Small Entity  | Fee Description        | Fee Paid |
|---------------------|---------------|------------------------|----------|
| Fee Code (\$)       | Fee Code (\$) |                        |          |
| 1001 770            | 2001 385      | Utility filing fee     |          |
| 1002 340            | 2002 170      | Design filing fee      |          |
| 1003 530            | 2003 265      | Plant filing fee       |          |
| 1004 770            | 2004 385      | Reissue filing fee     |          |
| 1005 160            | 2005 80       | Provisional filing fee |          |
| <b>SUBTOTAL (1)</b> |               | <b>(\$ 0.00)</b>       |          |

## 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

| Total Claims       | Extra Claims | Fee from below | Fee Paid |
|--------------------|--------------|----------------|----------|
| Independent Claims | - 20** =     | X              | =        |
| Multiple Dependent | - 3** =      | X              | =        |

| Large Entity        | Small Entity  | Fee Description  |
|---------------------|---------------|--|
| Fee Code (\$)       | Fee Code (\$) |  |
| 1202 18             | 2202 9        | Claims in excess of 20                                     |
| 1201 86             | 2201 43       | Independent claims in excess of 3                          |
| 1203 290            | 2203 145      | Multiple dependent claim, if not paid                      |
| 1204 86             | 2204 43       | ** Reissue independent claims over original patent         |
| 1205 18             | 2205 9        | ** Reissue claims in excess of 20 and over original patent |
| <b>SUBTOTAL (2)</b> |               | <b>(\$ 0.00)</b>   |

\*or number previously paid, if greater; For Reissues, see above

## 3. ADDITIONAL FEES

Large Entity Small Entity

| Fee Code (\$) | Fee (\$)    | Fee Code (\$)  | Fee (\$) | Fee Description | Fee Paid |
|---------------|-------------|--|----------|-----------------|----------|
| 1051 130      | 2051 65     | Surcharge - late filing fee or oath  |          |                 |          |
| 1052 50       | 2052 25     | Surcharge - late provisional filing fee or cover sheet                     |          |                 |          |
| 1053 130      | 1053 130    | Non-English specification  |          |                 |          |
| 1812 2,520    | 1812 2,520  | For filing a request for ex parte reexamination                            |          |                 |          |
| 1804 920*     | 1804 920*   | Requesting publication of SIR prior to Examiner action                     |          |                 |          |
| 1805 1,840*   | 1805 1,840* | Requesting publication of SIR after Examiner action                        |          |                 |          |
| 1251 110      | 2251 55     | Extension for reply within first month                                     |          |                 |          |
| 1252 420      | 2252 210    | Extension for reply within second month                                    |          |                 |          |
| 1253 950      | 2253 475    | Extension for reply within third month                                     |          |                 |          |
| 1254 1,480    | 2254 740    | Extension for reply within fourth month                                    |          |                 |          |
| 1255 2,010    | 2255 1,005  | Extension for reply within fifth month                                     |          |                 |          |
| 1401 330      | 2401 165    | Notice of Appeal   |          |                 |          |
| 1402 330      | 2402 165    | Filing a brief in support of an appeal                                     |          |                 | 340.00   |
| 1403 290      | 2403 145    | Request for oral hearing   |          |                 |          |
| 1451 1,510    | 1451 1,510  | Petition to institute a public use proceeding                              |          |                 |          |
| 1452 110      | 2452 55     | Petition to revive - unavoidable   |          |                 |          |
| 1453 1,330    | 2453 665    | Petition to revive - unintentional   |          |                 |          |
| 1501 1,330    | 2501 665    | Utility issue fee (or reissue)   |          |                 |          |
| 1502 480      | 2502 240    | Design issue fee   |          |                 |          |
| 1503 640      | 2503 320    | Plant issue fee  |          |                 |          |
| 1460 130      | 1460 130    | Petitions to the Commissioner  |          |                 |          |
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| 1810 770      | 2810 385    | For each additional invention to be examined (37 CFR 1.129(b))             |          |                 |          |
| 1801 770      | 2801 385    | Request for Continued Examination (RCE)                                    |          |                 |          |
| 1802 900      | 1802 900    | Request for expedited examination of a design application                  |          |                 |          |

Other fee (specify) \_\_\_\_\_

\*Reduced by Basic Filing Fee Paid

**SUBTOTAL (3) (\$ 340.00)**

(Complete if applicable)

|                   |   |                                   |        |           |              |
|-------------------|---|-----------------------------------|--------|-----------|--------------|
| Name (Print/Type) | Leonard T. Guzman   | Registration No. (Attorney/Agent) | 46,308 | Telephone | 408-927-3377 |
| Signature         |  |                                   |        |           |              |
| Date              | 10/6/2004   |                                   |        |           |              |

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PATENT

**IN THE UNITED STATES**  
**PATENT AND TRADEMARK OFFICE**

**Title:** "SYSTEM AND TECHNIQUE FOR DYNAMICALLY INTERJECTING LIVE ADVERTISEMENTS IN THE CONTEXT OF REAL-TIME ISOCHRONOUS (TELEPHONE-MODEL) DISCOURSE"

**Applicants:** Ford et al.

**Attorney Docket No.:** AM9-99-0165

**Serial No.:** 09/513,646

**Examiner:** Ovidio Escalante

**Filed:** February 25, 2000

**Art Unit:** 2645

5

Mail Stop: Board of Patent Appeals and Interferences  
Commissioner for Patents  
P.O.Box 1450  
Alexandria, VA 22313-1450

**APPEAL BRIEF**

Dear Sir:

This appeal brief is submitted under 35 U.S.C. §134. This appeal is further to Appellants'

10 Notice of Appeal filed August 6, 2004.

**Table of Contents**

| <u>Section</u> | <u>Title</u>                                  | <u>Page</u> |
|----------------|---|-------------|
| (1)            | Real Party in Interest                        | 2           |
| (2)            | Related Appeals and Interferences             | 2           |
| (3)            | Status of Claims                              | 2           |
| (4)            | Status of Amendments                          | 2           |
| (5)            | Summary of Claimed Subject Matter             | 2           |
| (6)            | Grounds of Rejection to be Reviewed on Appeal | 7           |
| (7)            | Argument                                      | 7           |
| App. A         | Claims Appendix                               | 34          |
| App. B         | Evidence Appendix                             | 39          |
| App. C.        | Related Proceedings Appendix                  | 40          |

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**(1) Real Party in Interest**

The real party in interest is International Business Machines Corporation.

**(2) Related Appeals and Interferences**

No other appeals or interferences exist that relate to the present application or appeal.

5

**(3) Status of Claims**

Claims 1-13 are pending and remain in the application. By the Final Office Action dated May 6, 2004, the Examiner has rejected claims 1-13 under 35 U.S.C. § 103(a). In particular, the Examiner has rejected claims 1, 2, 5, 6, 10, and 11 as being unpatentable over Ordish, U.S. Patent No. 5,195,031 (hereinafter Ordish) in view of Sawyer, U.S. Patent No. 6,351,279 (hereinafter Sawyer). In addition, the Examiner has rejected claims 3, 4, 7-9, 12, and 13 as being unpatentable over Sawyer in view of Ordish. All of the pending claims and all of the rejections are hereby appealed. A copy of the appealed claims is enclosed herewith as Appendix A.

**(4) Status of Amendments**

15 No amendments are outstanding.

**(5) Summary of Claimed Subject Matter**

**Independent Claim 1**

Independent claim 1 relates to a method of interjecting messages into a real-time isochronous discourse between a plurality of users, where the method includes the steps of (1) providing a system for accessing a real-time isochronous discourse on a telephone between two or more callers, (2) accessing a real-time isochronous discourse on the telephone between two or more callers, (3) monitoring the discourse on the telephone between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system, (4) communicating the desired message via the telephone to the callers when the discourse is determined to be related to the desired message, and (5) continuing the above

steps until the discourse being accessed is terminated by the callers or the system. (Please see Application as Filed, page 17, lines 1-9.)

**Independent Claim 3**

Independent claim 3 relates to a method of interjecting messages into a real-time

- 5 isochronous discourse between a plurality of callers is provided, where the method includes the steps of (1) forming a system including (a) a system interface for inputting and storing system parameters by an owner of the system, (b) a communication media interface for communicating with a telephone system being used by two or more callers, (c) a conversation content analyzer and summarizer for determining if the communication on the telephone  
10 system between the callers is relevant to the system parameters, (d) a database for storing system data including system messages to be transmitted to the callers, (e) a database manager for matching system parameters with the communication on the telephone system between the callers, and (f) a caller interface for communicating the system data and/or messages to one or more of the callers, (2) accessing the telephone system being used by two  
15 or more callers using the communication media interface, (3) monitoring the communication on the telephone system between the callers using the communication media interface, (4) analyzing the conversation on the telephone system using the conversation content analyzer and summarizer, (5) determining if there is a match between the conversation on the telephone system and one or more of the system parameters using the database manager, (6)  
20 sending the system data from the database to the database manager if there is a match and choosing a suitable message from the database for communication to the caller, and (7) transmitting the message via the telephone system to the callers using the caller interface.

(Please see Application as Filed, page 17, lines 1-13 to page 18, lines 14-26.)

**Independent Claim 5**

- 25 Independent claim 5 relates to a system for interjecting messages into a real-time isochronous discourse between a plurality of users, where the system includes (1) means for accessing a real-time isochronous discourse on a telephone between two or more callers, (2) means for monitoring the discourse on the telephone between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system, and

(3) means for communicating the desired message via the telephone to the callers when the discourse is determined to be related to the desired message. (Please see Application as Filed, page 18, lines 1-7.)

The means plus function “means for accessing a real-time isochronous discourse on a telephone between two or more callers” of claim 5 corresponds to the following structure, material, or acts described in the specification as corresponding to the claimed function: “Specifically, based upon the system owner’s inputting and storing system parameters, the system will access a telephone conversation between one or more callers and look for a match between system parameters and the conversation, e.g., the temporally contiguous occurrence of a particular keyword or set of keywords.” (Please see Application as Filed, page 8, lines 16-19.)

The means plus function “means for monitoring the discourse on the telephone between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system” of claim 5 corresponds to the following structure, material, or acts described in the specification as corresponding to the claimed function: “The use of the above parameters by the system will be further described hereinbelow but it should be understood that any number of parameters can be used depending on how the system is to be used with the system essentially providing access to a real-time isochronous discourse between two or more callers which discourse is monitored and when the discourse is determined to relate to a message desired to be communicated to the callers by the system, the desired message is communicated”. (Please see Application as Filed, page 10, lines 7-13.).

The means plus function “means for communicating the desired message via the telephone to the callers when the discourse is determined to be related to the desired message” of claim 5 corresponds to the following structure, material, or acts described in the specification as corresponding to the claimed function: “The use of the above parameters by the system will be further described hereinbelow but it should be understood that any number of parameters can be used depending on how the system is to be used with the system essentially providing access to a real-time isochronous

discourse between two or more callers which discourse is monitored and when the discourse is determined to relate to a message desired to be communicated to the callers by the system, the desired message is communicated". (Please see Application as Filed, page 10, lines 7-13.).

5        **Independent Claim 7**

Independent claim 7 relates to a system for interjecting messages into a real-time isochronous discourse between a plurality of callers, where the system includes (1) means for forming a system including (a) a system interface for inputting and storing system parameters by the owner of the system, (b) a communication media interface for communicating with a telephone system being used by two or more callers, (c) a conversation content analyzer and summarizer for determining if the communication on the telephone system between the callers is relevant to the system parameters, (d) a database for storing system data including system messages to be transmitted to the callers, (e) a database manager for matching system parameters with the communication on the telephone system between the callers, and (f) a caller interface for communicating the system data and/or messages to one or more of the callers and (2) where the telephone system being used by two or more callers is accessed using the communication media interface, (a) the communication on the telephone system between the callers is monitored using the communication media interface, (b) the conversation on the telephone system is analyzed using the conversation content analyzer and summarizer, and (c) the conversation on the telephone system is compared with one or more of the system parameters using the database manager and, if there is a match, sending the system data from the database to the database manager and choosing a suitable message from the database for communication to the callers and transmitting the message via the telephone system to the callers using the caller interface. (Please see Application as Filed, page 18, lines 1-2 to page 19, lines 3-24.)

The means plus function "means for forming a system" of claim 7 corresponds to the following structure, material, or acts described in the specification as corresponding to the claimed function: "The owner or operator of the system would merely need to specify system parameters such as sets of keywords, typically sequence dependent, to be detected in the

context of the conversation and intended to be matched to trigger interjecting advertisements into the telephone conversation.” (Please see Application as Filed, page 9, lines 22-25.)

**Independent Claim 10**

- Independent claim 10 relates to a program storage device readable by a machine,
- 5 tangibly embodying a program of instructions executable by the machine to perform method steps for interjecting messages into a real-time isochronous discourse between a plurality of users including the steps of (1) providing a system for accessing a real-time isochronous discourse on a telephone between two or more callers, (2) accessing a real-time isochronous discourse on the telephone between two or more callers, (3) monitoring the discourse on the
- 10 telephone between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system, (4) communicating the desired message via the telephone to the callers when the discourse is determined to be related to the desired message, and (5) continuing the above steps until the discourse being accessed is terminated by the callers or the system. (Please see Application as Filed, page 20, lines 1-13.)

**Independent Claim 12**

- Independent claim 12 relates to a A program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to perform a method of interjecting messages into a real-time isochronous discourse between a plurality of callers including the steps of (1) forming a system including (a) a system interface for inputting and storing system parameters by an owner of the system, (b) a communication media interface for communicating with a telephone system being used by two or more callers, (c) a conversation content analyzer and summarizer for determining if the communication on the telephone system between the callers is relevant to the system parameters, (d) a database for storing system data including system messages to be transmitted to the callers, (e) a database manager for matching system parameters with the communication on the telephone system between the callers, and (f) a caller interface for communicating the system data and/or messages to one or more of the callers, (2) accessing the telephone system being used by two or more callers using the communication media interface, (3) monitoring the communication on the telephone system between the callers using the communication media interface, (4)

analyzing the conversation on the telephone system using the conversation content analyzer and summarizer, (5) determining if there is a match between the conversation on the telephone system and one or more of the system parameters using the database manager, (6) sending the system data from the database to the database manager if there is a match and 5 choosing a suitable message from the database for communication to the callers, and (7) transmitting the message via the telephone system to the callers using the caller interface. (Please see Application as Filed, page 20, lines 1-11 to page 21, lines 12-28.)

#### **(6)        Grounds of Rejection to be Reviewed on Appeal**

The first issue for review is whether claims 1, 2, 5, 6, 10, and 11 are unpatentable over 10 Ordish in view of Sawyer. The second issue for review is whether claims 3, 4, 7-9, 12, and 13 are unpatentable over Sawyer in view of Ordish.

#### **(7)        Argument**

##### **A. Introduction**

The first issue for review is whether claims 1, 2, 5, 6, 10, and 11 are unpatentable over 15 Ordish in view of Sawyer. The second issue for review is whether claims 3, 4, 7-9, 12, and 13 are unpatentable over Sawyer in view of Ordish.

##### **B. Whether claims 1, 2, 5, 6, 10, and 11 are unpatentable over Ordish in view of Sawyer**

Applicants respectfully traverse the obviousness rejection of claims 1, 2, 5, 6, 10, and 11 over Ordish in view of Sawyer, and submit that claims 1, 2, 5, 6, 10, and 11 are not obvious 20 over Ordish in view of Sawyer, and are patentable thereover. In support of this position, Applicants submit the following argument.

###### **1. Legal Standards for Obviousness**

The following legal authorities set the general standards in support of Applicant's position of non obviousness, with emphasis added for added clarity:

25

- MPEP §2143.03, "All Claim Limitations Must Be Taught or Suggested: To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

5        "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."

- MPEP §2143.01, "The Prior Art Must Suggest The Desirability Of The Claimed Invention: There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).
- "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." In re Fine, 837 F.2d at 1075, 5 USPQ2d at 1598 (citing ACS Hosp. Sys. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). What a reference teaches and whether it teaches toward or away from the claimed invention are questions of fact. See Raytheon Co. v. Roper Corp., 724 F.2d 951, 960-61, 220 USPQ 592, 599-600 (Fed. Cir. 1983), cert. denied, 469 U.S. 835, 83 L. Ed. 2d 69, 105 S. Ct. 127 (1984). "
- "When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. See In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)." Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See MPEP 2143.01; In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).
- "With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience -- or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings." See In re Zurko, 258 F.3d 1379 (Fed. Cir. 2001).
- "We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in

the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg. v. SGS Imports Intern., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," Rouffet, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard, 157 F.3d at 1352, 48 USPQ2d at 1232. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact."); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977)." See In re Dembicza, 175 F.3d 994 (Fed. Cir. 1999).

- "To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." See In re Rouffet, 149, F.3d 1350 (Fed. Cir. 1998).
- The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).
- If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

## 2. Application of the Obviousness Standard to the Present Invention

By the Final Office Action dated May 6, 2004, the Examiner has rejected claims 1, 2, 5, 6, 10, and 11 as being unpatentable over Ordish in view of Sawyer. In order to form a proper obviousness rejection of a claim under 35 U.S.C. § 103(a), a collection of references together must teach or suggest each element of the claim, including the relationships between

the elements. If any element is not fully taught by the combined references, the rejection cannot be sustained.

Evaluating Ordish in view of Sawyer in this light, it is appropriate to examine the portions of Ordish in view of Sawyer that the Examiner has pointed to as teaching the claimed elements of the rejected claims.

5 The Examiner has asserted that

[r]egarding claims 1, 2, 5, 6, 10, and 11, Ordish teaches a method, program storage device readable by a machine to perform the method steps and a system comprising means for interjecting messages into a real-time isochronous discourse between a plurality of users (abstract; col. 2, line 57-col. 3, line 32) comprising: providing a system (col. 3, lines 12-18; col. 5, lines 26-44) for accessing a real-time isochronous discourse on a video communication between two or more callers, (col. 5, lines 26-64);  
10 accessing a real-time isochronous discourse on a video communication between two or more callers, (col. 3, lines 12-18; col. 5, lines 44-64); monitoring the discourse on the video communication between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system, (col. 3, lines 18-32; col. 5, lines 44-64; col. 10,  
15 lines 63-col. 11, lines 17; abstract); and communicating the desired message via the video communication to the callers when the discourse is determined to be related to the desired message, (col. 3, lines 1-32); and continuing the above steps until the discourse being accessed is terminated by the callers or the system, (col. 3, lines 1-32).

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(See Final Office Action, page 2, paragraph 5 to page 3.) Then, the Examiner asserted that "Ordish teaches that it was well known to use landline connections in a telephone network for video communication and that two way conversations via the telephone was well known in

25

the art . . . [and] [that] Ordish further suggests in col. 5, lines 51-55 that any type of video communication can be used.” (See Final Office Action, page 3, paragraph 1.)

The Examiner then admitted that “Ordish, however, does not specifically teach of the discourse occurring via a telephone.” (See Final Office Action, page 3, paragraph 1.) The

- 5 Examiner then asserted that “Sawyer teaches that it was well known in the art to communicate a desired message via a video telephone (‘on a telephone’) to callers, (abstract; col. 1, lines 63-65; col. 2, line 63-col.3, line 8).” (See Final Office Action, page 3, paragraph 2.) Finally, the Examiner asserted that

- 10 it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Ordish by including a telephone for making the call as taught and suggested by Sawyer so that any type of video communication can be used as suggested by Ordish and so that video telephone can be used to provide voice communication to the end users as taught by Sawyer.
- 15

(See Final Office Action, page 3, paragraph 3.)

**Claim 1**

- To the extent the Examiner's language at pages 2 and 3 of the Final Office Action can  
20 be understood, it appears that the Examiner has asserted the following correspondence between Ordish and Sawyer and claim 1:

| <b>Claim 1</b>   | <b><u>Ordish</u></b>              | <b><u>Sawyer</u></b> |
|--|-----------------------------------|----------------------|
| A method of interjecting messages into a real-time isochronous discourse between a plurality of users comprising the steps of: | -                                 | -                    |
| providing a system   | <u>Ordish</u> does not teach this | -                    |

|  |  |  |
|--|--|--|
| <p>for accessing a real-time isochronous discourse <i>on a telephone</i> between two or more callers;</p> <p>accessing a real-time isochronous discourse <i>on the telephone</i> between two or more callers;</p> <p>monitoring the discourse <i>on the telephone</i> between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system;</p> <p>communicating the desired message <i>via the telephone</i> to the callers when the discourse is determined to be related to the desired message; and</p> <p>continuing the above steps until the discourse being accessed is terminated by the callers or</p> | <p>claim element.</p> <p><u>Ordish</u> does not teach this claim element.</p> <p><u>Ordish</u> does not teach this claim element.</p> <p><u>Ordish</u> does not teach this claim element.</p> <p>-</p> | <p>-</p> <p><u>Sawyer</u> does not teach this claim element.</p> <p><u>Sawyer</u> does not teach this claim element.</p> |
|--|--|--|

the system.

In reviewing the cited portions of Ordish and Sawyer, however, it becomes apparent that Ordish and Sawyer have been generalized, and, in fact, does not support the position asserted by the Examiner.

5                   monitoring the discourse *on the telephone* between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system

In particular, Ordish and Sawyer, alone or in combination, fail to teach or suggest “monitoring the discourse *on the telephone* between the callers to determine if the discourse 10 relates to a message desired to be communicated to the callers by the system”, as required by claim 1, as amended. Since the Examiner admitted that “Ordish, however, does not specifically teach of the discourse occurring via a telephone.” (See Final Office Action, page 3, paragraph 1.), Ordish cannot teach the claim 1 element of “monitoring the discourse *on the telephone* between the callers to determine if the discourse relates to a message desired to be 15 communicated to the callers by the system” since Ordish does not teach that the discourse that it is monitoring is “occurring via a telephone”, and, thus, Ordish cannot teach or suggest the claim 1 element of “monitoring the discourse *on the telephone* between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system”. Moreover, Ordish teaches away from the claim 1 element of “monitoring the 20 discourse *on the telephone* between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system” because Ordish discloses obtaining “characters from the text buffer using the routine readch as described above [and] . . . [i]f the characters constitute a recognized word in the vocabulary, a reference to this word is preferably recorded.” (See Ordish, col. 11, lines 7-11.) Thus, Ordish discloses monitoring 25 text in a text buffer and monitoring a *textual* discourse on a *video communication device* that can display the textual discourse and not discourse on a *telephone* between callers, as required by claim 1. Also, Ordish teaches away from this claim 1 element because Ordish specifically discloses a video communication trading system that attempts to solve the problems of using a

telephone system to analyze and transmit trading messages by affirmatively saying that a “telephone system does not provide any hard copy nor does it allow you to, on the same device, obtain supplementary data while carrying on the conversation . . . [where] [s]uch supplementary data may be particularly important if the purpose of the conversation is

5 commodity dealing, such as in the money or foreign exchange market.” (See Ordish, col. 1, lines 37-43.) In other words, Ordish specifically disavows using a telephone system to monitor discourse between callers for at least this reason. Therefore, Ordish cannot teach or suggest the claim 1 element of “monitoring the discourse *on the telephone* between the callers to determine if the discourse relates to a message desired to be communicated to the callers by

10 the system”.

In addition, since the Examiner admitted that Sawyer does not teach “monitoring the discourse between the callers” (See First Office Action, page 6, paragraph 1.), Sawyer cannot teach or suggest the claim 1 element of “monitoring the discourse *on the telephone* between the callers to determine if the discourse relates to a message desired to be communicated to

15 the callers by the system”. Therefore, Ordish and Sawyer, alone or in combination, alone or in combination, cannot teach or suggest the claim 1 element of “monitoring the discourse *on the telephone* between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system”.

20 communicating the desired message via the telephone to the  
callers when the discourse is determined to be related to the  
desired message

Also, Ordish and Sawyer, alone or in combination, alone or in combination, fail to teach or suggest “communicating the desired message *via the telephone* to the callers when the discourse is determined to be related to the desired message”, as required by claim 1, as

25 amended. Ordish teaches away from this claim 1 element because Ordish specifically discloses a video communication trading system that attempts to solve the problems of using a telephone system to analyze and transmit trading messages by affirmatively saying that a “telephone system does not provide any hard copy nor does it allow you to, on the same device, obtain supplementary data while carrying on the conversation . . . [where] [s]uch

supplementary data may be particularly important if the purpose of the conversation is commodity dealing, such as in the money or foreign exchange market.” (See Ordish, col. 1, lines 37-43.) In other words, Ordish specifically disavows using a telephone system to communicate messages between callers for at least this reason. Therefore, Ordish cannot

5 teach or suggest the claim 1 element of “communicating the desired message *via the telephone* to the callers when the discourse is determined to be related to the desired message”. Since the Examiner admitted that Sawyer does not teach “communication a message related to the discourse” (See First Office Action, page 6, paragraph 1.), Sawyer cannot teach or suggest the claim 1 element of “communicating the desired message *via the telephone* to the callers when the discourse is determined to be related to the desired message”.

10 10 Ordish and Sawyer, alone or in combination, cannot teach or suggest the claim 1 element of “communicating the desired message *via the telephone* to the callers when the discourse is determined to be related to the desired message”.

It is therefore clear that Ordish and Sawyer, alone or in combination, cannot teach or

15 suggest each element of claim 1 and, therefore, a rejection of claim 1 under 35 U.S.C. § 103(a) is inappropriate.

### Claim 2

Since dependent claim 2 depends on claim 1 and since Ordish and Sawyer, alone or in combination, cannot teach or suggest each element of claim 1, Ordish and Sawyer, alone or in

20 combination, cannot teach or suggest each element of claim 2, and, therefore, a rejection of claim 2 under 35 U.S.C. § 103(a) is inappropriate.

### Claim 5

To the extent the Examiner's language at pages 2 and 3 of the Final Office Action can be understood, it appears that the Examiner has asserted the following correspondence

25 between Ordish and Sawyer and claim 5, as amended:

| <u>Claim 5</u>  | <u>Ordish</u> | <u>Sawyer</u> |
|---|---------------|---------------|
| A system for interjecting messages into a real-time isochronous discourse | -             | -             |

|   |   |   |
|---|---|---|
| <p>between a plurality of users comprising:</p>   | <p>means for accessing a real-time isochronous discourse <i>on a telephone</i> between two or more callers;</p> | <p><u>Ordish</u> does not teach this claim element.</p> |
| <p>means for monitoring the discourse <i>on the telephone</i> between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system; and</p> | <p><u>Ordish</u> does not teach this claim element.</p>   | <p><u>Sawyer</u> does not teach this claim element.</p> |
| <p>means for communicating the desired message <i>via the telephone</i> to the callers when the discourse is determined to be related to the desired message.</p>                                     | <p><u>Ordish</u> does not teach this claim element.</p>   | <p><u>Sawyer</u> does not teach this claim element.</p> |

In reviewing the cited portions of Ordish and Sawyer, however, it becomes apparent that Ordish and Sawyer have been generalized, and, in fact, does not support the position asserted by the Examiner.

**means for monitoring the discourse *on the telephone* between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system**

In particular, Ordish and Sawyer, alone or in combination, fail to teach or suggest

- 5 "means for monitoring the discourse *on the telephone* between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system", as required by claim 5, as amended, for similar reasons that Ordish and Sawyer, alone or in combination, cannot teach or suggest the claim 1 element of "monitoring the discourse *on the telephone* between the callers to determine if the discourse relates to a message desired to be  
10 communicated to the callers by the system".

**means for communicating the desired message *via the telephone* to the callers when the discourse is determined to be related to the desired message**

- Also, Ordish and Sawyer, alone or in combination, fail to teach or suggest "means for  
15 communicating the desired message *via the telephone* to the callers when the discourse is determined to be related to the desired message", as required by claim 5, as amended, for similar reasons that Ordish and Sawyer, alone or in combination, cannot teach or suggest the claim 1 element of "communicating the desired message *via the telephone* to the callers when the discourse is determined to be related to the desired message".

- 20 It is therefore clear that Ordish and Sawyer, alone or in combination, cannot teach or suggest each element of claim 5 and, therefore, a rejection of claim 5 under 35 U.S.C. § 103(a) is inappropriate.

**Claim 6**

- Since dependent claim 6 depends on claim 5 and since Ordish and Sawyer, alone or in  
25 combination, cannot teach or suggest each element of claim 5, Ordish and Sawyer, alone or in combination, cannot teach or suggest each element of claim 6, and, therefore, a rejection of claim 6 under 35 U.S.C. § 103(a) is inappropriate.

**Claim 10**

Since claim 10, as amended, is the program storage device version of claim 1, as amended, with the same elements as claim 1, as amended, and since Ordish and Sawyer, alone or in combination, cannot teach or suggest each element of claim 1, as amended, Ordish and Sawyer, alone or in combination, cannot teach or suggest each element of claim 10, as amended, and therefore, a rejection of claim 10, as amended, under 35 U.S.C. § 103(a) is inappropriate.

### **Claim 11**

Since dependent claim 11 depends on claim 10 and since Ordish and Sawyer, alone or in combination, cannot teach or suggest each element of claim 10, Ordish and Sawyer, alone or in combination, cannot teach or suggest each element of claim 11, and, therefore, a rejection of claim 11 under 35 U.S.C. § 103(a) is inappropriate.

### **C. Whether claims 3, 4, 7-9, 12, and 13 are unpatentable over Sawyer in view of Ordish**

Applicants respectfully traverse the obviousness rejection of claims 3, 4, 7-9, 12, and 13 over Sawyer in view of Ordish, and submit that claims 3, 4, 7-9, 12, and 13 are not obvious over Sawyer in view of Ordish, and are patentable thereover. In support of this position, Applicants submit the following argument.

#### **1. Legal Standards for Obviousness**

The following legal authorities set the general standards in support of Applicant's position of non obviousness, with emphasis added for added clarity:

- MPEP §2143.03, "All Claim Limitations Must Be Taught or Suggested: To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."
- MPEP §2143.01, "The Prior Art Must Suggest The Desirability Of The Claimed Invention: There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of

the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

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- “Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination.” In re Fine, 837 F.2d at 1075, 5 USPQ2d at 1598 (citing ACS Hosp. Sys. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). What a reference teaches and whether it teaches toward or away from the claimed invention are questions of fact. See Raytheon Co. v. Roper Corp., 724 F.2d 951, 960-61, 220 USPQ 592, 599-600 (Fed. Cir. 1983), cert. denied, 469 U.S. 835, 83 L. Ed. 2d 69, 105 S. Ct. 127 (1984). “
- 15 • “When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. See In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987).” Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See MPEP 2143.01; In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).
- 25 • “With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience -- or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.” See In re Zurko, 258 F.3d 1379 (Fed. Cir. 2001).
- 30 • “We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg. v. SGS Imports Intern., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although “the suggestion more often comes from the teachings of the pertinent references,” Rouffet, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard, 157 F.3d at 1352, 48 USPQ2d at 1232. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not “evidence.” E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) (“Mere denials and conclusory statements, however, are not sufficient to establish a

genuine issue of material fact."); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977)." See In re Dembiczak, 175 F. 3d 994 (Fed. Cir. 1999).

- 5 • "To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." See In re Rouffet, 149, F.3d 1350 (Fed. Cir. 1998).
- 10
- 15 • The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).
- 20
- 25 • If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

## 25      2. Application of the Obviousness Standard to the Present Invention

By the Final Office Action dated April 15, 2003, the Examiner has rejected claims 3, 4, 7-9, 12, and 13 as being unpatentable over Sawyer in view of Ordish. In order to form a proper obviousness rejection of a claim under 35 U.S.C. § 103(a), a collection of references together must teach or suggest each element of the claim, including the relationships between the elements. If any element is not fully taught by the combined references, the rejection cannot be sustained.

Evaluating Sawyer in view of Ordish in this light, it is appropriate to examine the portions of Sawyer in view of Ordish that the Examiner has pointed to as teaching the claimed elements of the rejected claims.

35      The Examiner has asserted that

[r]egarding claims 3, 7 and 12, Sawyer teaches a method, system and

program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to perform the method and a system comprising means for interjecting messages into a real-time isochronous discourse between a plurality of callers

5 is provided (abstract; col. 1, lines 63-65; col. 3, line 63-65; col. 3, lines 29-52) comprising: forming a system comprising: a system interface for inputting and storing system parameters by an owner of the system, (col. 4, lines 8-32); a communication media interface for communicating with a telephone system (video telephone system) being used by two or more callers, (col. 2, line 63-col. 3, line 8; fig. 3); a database for storing system data including system messages to be transmitted to the callers, (col. 3, lines 9-28); a caller interface for communicating the system data and/or messages to one or more of the callers, (col. 3, lines 9-8, col. 4, lines 33-50).

10  
15 (See Final Office Action, page 4, paragraph 1.) Then, the Examiner admitted that "Sawyer does not specifically teach of a conversation analyzer and choosing a message based on the conversation." (See Final Office Action, page 4, paragraph 1.)

The Examiner then asserted that

20  
25 Ordish teachest that it was well known in the art to have a conversation content analyzer and summarizer for determining if the communication on the video communication system between the callers is relevant to the systemb parameters, (col. 2, line 57- col. 3, line 32); a database manager for matching system parameters with the communication on the video communication system between the callers, (col. 3, lines 12-18; col. 5, lines 26-64); and accessing the video communication system being used by two or more callers using the communication media interface, (col. 3, lines 12-18; col.5, lines 44-64);

monitoring the communication on the video communication system between the callers using the communication media interface, (col. 10, line 63-col. 11, line 17; col. 5, lines 44-64; abstract); analyzing the conversation on the video communication system using the conversation content analyzer and summarizer, (col. 3, lines 1-32; col. 5, lines 44-64); determining if there is a match between the conversation on the video communication system and one or more of the system parameters using the database manager, (col. 5, lines 44-64); sending the system data from the database to the database manager if there is a match and choosing a suitable message from the database for communication to the callers, (col. 3, lines 1-32; col. 10, line 63-col. 11, line 17; and transmitting the message via the video communication system to the callers using the caller interface, (col. 3, lines 1-32).

15 (See Final Office Action, page 4, paragraph 3 to page 5.) Then, the Examiner asserted that

since Ordish teaches that it was well known to use landline connections in a telephone network for video communication and since Sawyer teaches that the video communication is a video telephone communication then one skilled in the art would have used the well known teaching of monitoring video communications as shown by Ordish into the video communication (video telephony system) of Sawyer so that real-time messages can be sent to the end parties.

25 (See Final Office Action, page 5, paragraph 1 to page 6.)

Finally, the Examiner asserted that

[t]herefore, it would have been obvious to one of ordinary skill

in the art at the time the invention was made to modify the system  
of Sawyer by using a conversation analyzer to provide the callers  
with customized announcements based on their conversation as  
taught by Ordish so that the system can provide adaptive  
5 advertisements that is based upon the users interest and transactions  
based on their real-time conversation.

(See Final Office Action, page 6, paragraph 1.)

**Claim 3**

10 To the extent the Examiner's language at pages 3-6 of the Final Office Action can be understood, it appears that the Examiner has asserted the following correspondence between Sawyer and Ordish and claim 3, as amended:

| <b>Claim 3</b>   | <b><u>Sawyer</u></b>                             | <b><u>Ordish</u></b>                             |
|--|--|--|
| A method of interjecting messages into a real-time isochronous discourse between a plurality of callers is provided comprising the steps of: | -  | -  |
| forming a system comprising:   | <u>Sawyer</u> does not teach this claim element. | <u>Ordish</u> does not teach this claim element. |
| a system interface for inputting and storing system parameters by an owner of the system;  | -  | -  |
| a  | -  | <u>Ordish</u> does not teach this                |

|   |   |   |
|---|---|---|
| <p>communication media interface for communicating with a <i>telephone</i> system being used by two or more callers;</p> <p>a conversation content analyzer and summarizer for determining if the communication <i>on the telephone system</i> between the callers is relevant to the system parameters;</p> <p>a database for storing system data including system messages to be transmitted to the callers;</p> <p>a database manager for matching system parameters with the communication <i>on the telephone system</i> between the callers; and</p> <p>a caller interface for communicating the system data and/or messages to</p> | <p><u>Sawyer</u> does not teach this claim element.</p> <p>-</p> <p><u>Sawyer</u> does not teach this claim element.</p> <p>-</p> | <p>claim feature.</p> <p><u>Ordish</u> does not teach this claim feature.</p> <p>-</p> <p><u>Ordish</u> does not teach this claim feature.</p> <p>-</p> |
|---|---|---|

|  |   |   |
|--|---|---|
| <p>one or more of the callers; accessing the <i>telephone</i> system being used by two or more callers using the communication media interface;</p> <p>monitoring the communication <i>on the telephone system</i> between the callers using the communication media interface;</p> <p>analyzing the conversation <i>on the telephone system</i> using the conversation content analyzer and summarizer;</p> <p>determining if there is a match between the conversation <i>on the telephone system</i> and one or more of the system parameters using the database manager;</p> | <p><u>Sawyer</u> does not teach this claim element.</p> | <p><u>Ordish</u> does not teach this claim element.</p> |
|--|---|---|

|   |  |  |
|---|--|--|
| <p>sending the system data from the database to the database manager if there is a match and choosing a suitable message from the database for communication to the callers; and</p> <p>transmitting the message <i>via the telephone system</i> to the callers using the caller interface.</p> | <p><u>Sawyer</u> does not teach this claim element.</p> <p>-</p> | <p>-</p> <p><u>Ordish</u> does not teach this claim element.</p> |
|---|--|--|

In reviewing the cited portions of Sawyer and Ordish, however, it becomes apparent that Sawyer and Ordish have been generalized, and, in fact, does not support the position asserted by the Examiner.

5                   forming a system

In particular, Sawyer and Ordish, alone or in combination, fail to teach or suggest the “forming a system” element, as required by claim 3, as amended, since Sawyer and Ordish, alone or in combination, fail to teach or suggest all of the claim features of the “forming a system” element.

10                 a conversation content analyzer and summarizer for determining if the communication *on the telephone system* between the callers is relevant to the system parameters

In particular, Sawyer and Ordish, alone or in combination, fail to teach or suggest “a conversation content analyzer and summarizer for determining if the communication *on the telephone system* between the callers is relevant to the system parameters”, as required by claim 3, as amended. Since Ordish cannot teach the claim 1 feature of claim 1 element of

- “monitoring the discourse *on the telephone* between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system”, Ordish cannot teach this claim 3 feature of analyzing that which Ordish cannot monitor. Therefore, Ordish cannot teach or suggest the claim 3 feature of “a conversation content analyzer and
- 5      summarizer for determining if the communication *on the telephone system* between the callers is relevant to the system parameters”. Since the Examiner admitted that Sawyer does not teach “a conversation content analyzer”, Sawyer cannot teach or suggest the claim 3 feature of “a conversation content analyzer and summarizer for determining if the communication *on the telephone system* between the callers is relevant to the system parameters”. Therefore,
- 10     Sawyer and Ordish, alone or in combination, cannot teach or suggest the claim 3 feature of “a conversation content analyzer and summarizer for determining if the communication *on the telephone system* between the callers is relevant to the system parameters”. Since Sawyer and Ordish, alone or in combination, cannot teach or suggest all of the claim features of the “forming a system” element of claim 3, as amended, Sawyer and Ordish, alone or in
- 15     combination, cannot teach or suggest the claim 3 element of “forming a system”.

**monitoring the discourse *on the telephone* between the callers to  
determine if the discourse relates to a message desired to be  
communicated to the callers by the system**

- In addition, Sawyer and Ordish, alone or in combination, fail to teach or suggest
- 20     “monitoring the communication *on the telephone system* between the callers using the communication media interface”, as required by claim 3, as amended for similar reasons that Ordish and Sawyer, alone or in combination, cannot teach or suggest the claim 1 element of “monitoring the discourse *on the telephone* between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system”.

25     **analyzing the conversation *on the telephone system* using the  
conversation content analyzer and summarizer**

Also, Sawyer and Ordish, alone or in combination, fail to teach or suggest “analyzing the conversation *on the telephone system* using the conversation content analyzer and summarizer”, as required by claim 3, as amended for similar reasons that Sawyer and Ordish,

alone or in combination, cannot teach or suggest the the claim 3 feature of “a conversation content analyzer and summarizer for determining if the communication *on the telephone system* between the callers is relevant to the system parameters”.

- It is therefore clear that Sawyer and Ordish, alone or in combination, cannot teach or  
5 suggest each element of claim 3 and, therefore, a rejection of claim 3 under 35 U.S.C. §  
103(a) is inappropriate.

#### Claim 4

Since dependent claim 4 depends on claim 3 and since Sawyer and Ordish, alone or in combination, cannot teach or suggest each element of claim 3, Sawyer and Ordish, alone or in  
10 combination, cannot teach or suggest each element of claim 4 and, therefore, a rejection of claim 4 under 35 U.S.C. § 103(a) is inappropriate.

#### Claim 7

To the extent the Examiner's language at pages 6, 7, and 8 of the Office Action can be understood, it appears that the Examiner has asserted the following correspondence between  
15 Sawyer and Ordish and claim 3, as amended:

| <b>Claim 7</b>   | <b><u>Sawyer</u></b>                             | <b><u>Ordish</u></b>                             |
|--|--|--|
| A system is provided for interjecting messages into a real-time isochronous discourse between a plurality of callers comprising: | -  | -  |
| means for forming a system comprising:   | <u>Sawyer</u> does not teach this claim element. | <u>Ordish</u> does not teach this claim element. |
| a system interface for inputting and storing system parameters   | -  | -  |

|  |  |  |
|--|--|--|
| by the owner of the system;  |  |  |
| a communication media interface for communicating with a <i>telephone</i> system being used by two or more callers;  | -  | <u>Ordish</u> does not teach this claim feature. |
| a conversation content analyzer and summarizer for determining if the communication <i>on the telephone system</i> between the callers is relevant to the system parameters; | <u>Sawyer</u> does not teach this claim element. | <u>Ordish</u> does not teach this claim feature. |
| a database for storing system data including system messages to be transmitted to the callers;   | -  | -  |
| a database manager for matching system parameters with the communication <i>on the telephone system</i> between the callers; and   | <u>Sawyer</u> does not teach this claim element. | <u>Ordish</u> does not teach this claim feature. |
| a caller interface for   | -  | -  |

|  |  |   |
|--|--|---|
| <p>communicating the system data and/or messages to one or more of the callers;</p> <p>wherein the <i>telephone</i> system being used by two or more callers is accessed using the communication media interface;</p> <p>the communication <i>on the telephone system</i> between the callers is monitored using the communication media interface;</p> <p>the conversation <i>on the telephone system</i> is analyzed using the conversation content analyzer and summarizer; and</p> <p>the conversation <i>on the telephone system</i> is compared with one or more of the system parameters using the database manager</p> | <p>-</p> <p><u>Sawyer</u> does not teach this claim element.</p> | <p><u>Ordish</u> does not teach this claim feature.</p> |
|--|--|---|

|   |  |  |
|---|--|--|
| <p>and, if there is a match, sending the system data from the database to the database manager and choosing a suitable message from the database for communication to the callers and transmitting the message <i>via the telephone system</i> to the callers using the caller interface.</p> |  |  |
|---|--|--|

In reviewing the cited portions of Sawyer and Ordish, however, it becomes apparent that Sawyer and Ordish have been generalized, and, in fact, does not support the position asserted by the Examiner.

5                   **means for forming a system**

In particular, Sawyer and Ordish, alone or in combination, fail to teach or suggest the “means for forming a system” element, as required by claim 7, as amended. Since the “means for forming a system” element is the “means for” version of the “forming a system” element of claim 3 with the same elements as claim 3 and since Sawyer and Ordish, alone or in combination, cannot teach or suggest the “forming a system” element of claim 3, Sawyer and Ordish, alone or in combination, also cannot teach or suggest the claim 7 element of “means for forming a system”.

**the communication on the telephone system between the callers is monitored using the communication media interface**

10                  In addition, Sawyer and Ordish, alone or in combination, fail to teach or suggest “the communication *on the telephone system* between the callers is monitored using the communication media interface”, as required by claim 7, as amended. Sawyer and Ordish, alone or in combination, cannot teach or suggest the claim 3 element of “monitoring the

communication *on the telephone system* between the callers using the communication media interface”, Sawyer and Ordish, alone or in combination, cannot teach or suggest the claim 7 feature of “the communication *on the telephone system* between the callers is monitored using the communication media interface”.

5                   **the conversation *on the telephone system* is analyzed using the conversation content analyzer and summarizer**

Also, Sawyer and Ordish, alone or in combination, fail to teach or suggest “the conversation *on the telephone system* is analyzed using the conversation content analyzer and summarizer”, as required by claim 7, as amended. Since Sawyer and Ordish, alone or in  
10 combination, cannot teach or suggest the claim 3 element of “analyzing the conversation *on the telephone system* using the conversation content analyzer and summarizer”, Sawyer and Ordish, alone or in combination, cannot teach or suggest the claim 7 feature of “the conversation *on the telephone system* is analyzed using the conversation content analyzer and summarizer”.

15                  It is therefore clear that Sawyer and Ordish, alone or in combination, cannot teach or suggest each element of claim 7 and, therefore, a rejection of claim 7 under 35 U.S.C. § 103(a) is inappropriate.

**Claim 8**

Since dependent claim 8 depends on claim 7 and since Sawyer and Ordish, alone or in  
20 combination, cannot teach or suggest each element of claim 7, Sawyer and Ordish, alone or in combination, cannot teach or suggest each element of claim 8 and, therefore, a rejection of claim 8 under 35 U.S.C. § 103(a) is inappropriate.

**Claim 9**

Since dependent claim 9 depends on claim 8 and since Sawyer and Ordish, alone or in  
25 combination, cannot teach or suggest each element of claim 8, Sawyer and Ordish, alone or in combination, cannot teach or suggest each element of claim 9 and, therefore, a rejection of claim 9 under 35 U.S.C. § 103(a) is inappropriate.

**Claim 12**

Since claim 12, as amended, is the program storage device version of claim 3, as amended, with the same elements as claim 3, as amended, and since Sawyer and Ordish, alone or in combination, cannot teach or suggest each element of claim 3, as amended, Sawyer and Ordish, alone or in combination, cannot teach or suggest each element of claim 12, as amended, and therefore, a rejection of claim 12, as amended, under 35 U.S.C. § 103(a) is inappropriate.

**Claim 13**

Since dependent claim 13 depends on claim 12 and since Sawyer and Ordish, alone or in combination, cannot teach or suggest each element of claim 12, Sawyer and Ordish, alone or in combination, cannot teach or suggest each element of claim 13 and, therefore, a rejection of claim 13 under 35 U.S.C. § 103(a) is inappropriate.

**CONCLUSION**

All the claims presently on file in the present application are in condition for immediate allowance, and such action is respectfully requested. It is respectfully submitted that the application has now been brought into a condition where allowance of the case is proper. Reconsideration and issuance of a Notice of Allowance are respectfully solicited.

Respectfully Submitted,



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Date: October 6, 2004

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## **APPENDIX A**

### **CLAIMS APPENDIX**

5     1.     A method of interjecting messages into a real-time isochronous discourse between a plurality of users comprising the steps of:

       providing a system for accessing a real-time isochronous discourse on a telephone between two or more callers;

10    accessing a real-time isochronous discourse on the telephone between two or more callers;

       monitoring the discourse on the telephone between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system;

       communicating the desired message via the telephone to the callers when the discourse is determined to be related to the desired message; and

15    continuing the above steps until the discourse being accessed is terminated by the callers or the system.

2.     The method of claim 1 wherein the real-time isochronous discourse is a telephone call.

20    3.     A method of interjecting messages into a real-time isochronous discourse between a plurality of callers is provided comprising the steps of:

       forming a system comprising:

       a system interface for inputting and storing system parameters by an owner of the system;

25    a communication media interface for communicating with a telephone system being used by two or more callers;

       a conversation content analyzer and summarizer for determining if the communication on the telephone system between the callers is relevant to the system parameters;

- a database for storing system data including system messages to be transmitted to the callers;
- a database manager for matching system parameters with the communication on the telephone system between the callers; and
- 5           a caller interface for communicating the system data and/or messages to one or more of the callers;
- accessing the telephone system being used by two or more callers using the communication media interface;
- monitoring the communication on the telephone system between the callers using the
- 10           communication media interface;
- analyzing the conversation on the telephone system using the conversation content analyzer and summarizer;
- determining if there is a match between the conversation on the telephone system and one or more of the system parameters using the database manager;
- 15           sending the system data from the database to the database manager if there is a match and choosing a suitable message from the database for communication to the callers; and
- transmitting the message via the telephone system to the callers using the caller interface.
- 20          4.       The method of claim 3 wherein the isochronous discourse is a telephone call.
5.       A system for interjecting messages into a real-time isochronous discourse between a plurality of users comprising:
- means for accessing a real-time isochronous discourse on a telephone between two or
- 25           more callers;
- means for monitoring the discourse on the telephone between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system; and

means for communicating the desired message via the telephone to the callers when the discourse is determined to be related to the desired message.

6. The system of claim 5 wherein the isochronous discourse is a telephone call.

5

7. A system is provided for interjecting messages into a real-time isochronous discourse between a plurality of callers comprising:

means for forming a system comprising:

a system interface for inputting and storing system parameters by the owner of

10 the system;

a communication media interface for communicating with a telephone system being used by two or more callers;

a conversation content analyzer and summarizer for determining if the communication on the telephone system between the callers is relevant to the system

15 parameters;

a database for storing system data including system messages to be transmitted to the callers;

a database manager for matching system parameters with the communication on the telephone system between the callers; and

20 a caller interface for communicating the system data and/or messages to one or more of the callers;

wherein the telephone system being used by two or more callers is accessed using the communication media interface;

25 the communication on the telephone system between the callers is monitored using the communication media interface;

the conversation on the telephone system is analyzed using the conversation content analyzer and summarizer; and

the conversation on the telephone system is compared with one or more of the system parameters using the database manager and, if there is a match, sending the system

data from the database to the database manager and choosing a suitable message from the database for communication to the callers and transmitting the message via the telephone system to the callers using the caller interface.

- 5     8.     The system of claim 7 wherein the isochronous discourse is a telephone call.
9.     The system of claim 8 wherein different messages are provided to each caller.
10.    10.    A program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to perform method steps for interjecting messages into a real-time isochronous discourse between a plurality of users comprising the steps of:
  - providing a system for accessing a real-time isochronous discourse on a telephone between two or more callers;
  - accessing a real-time isochronous discourse on the telephone between two or more callers;
  - monitoring the discourse on the telephone between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system;
  - communicating the desired message via the telephone to the callers when the discourse is determined to be related to the desired message; and
- 20     continuing the above steps until the discourse being accessed is terminated by the callers or the system.
- 25     11.    The program storage device of claim 10 wherein the real-time isochronous discourse is a telephone call.
12.    12.    A program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to perform a method of interjecting messages into a real-time isochronous discourse between a plurality of callers comprising the steps of:
  - forming a system comprising:

- a system interface for inputting and storing system parameters by an owner of the system;
  - a communication media interface for communicating with a telephone system being used by two or more callers;
  - 5 a conversation content analyzer and summarizer for determining if the communication on the telephone system between the callers is relevant to the system parameters;
  - a database for storing system data including system messages to be transmitted to the callers;
  - 10 a database manager for matching system parameters with the communication on the telephone system between the callers; and
  - a caller interface for communicating the system data and/or messages to one or more of the callers;
  - 15 accessing the telephone system being used by two or more callers using the communication media interface;
  - monitoring the communication on the telephone system between the callers using the communication media interface;
  - analyzing the conversation on the telephone system using the conversation content analyzer and summarizer;
  - 20 determining if there is a match between the conversation on the telephone system and one or more of the system parameters using the database manager;
  - sending the system data from the database to the database manager if there is a match and choosing a suitable message from the database for communication to the callers; and
  - transmitting the message via the telephone system to the callers using the caller interface.

13. The program storage device of claim 12 wherein the real-time isochronous discourse is a telephone call.

## **APPENDIX B**

### **EVIDENCE APPENDIX**

- 5 There is no applicable evidence.

## **APPENDIX C**

### **RELATED PROCEEDINGS APPENDIX**

5 There are no related proceedings.